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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,411	11/03/2000	Michael Nowak	Y2K.0090	6773

7590 08/06/2002

Mathew R P Perrone Jr
210 South Main Street
Algonquin, IL 60102-2639

EXAMINER

HEWITT, JAMES M

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 08/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Applicati n N .	Applicant(s)
	09/705,411	NOWAK, MICHAEL
	Examiner James M Hewitt	Art Unit 3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 May 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 May 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The corrected or substitute drawings were received on 5/23/02. These drawings are acceptable.

Double Patenting

Applicant is advised that should claims 3-4 and 9-10 be found allowable, claims 5-6 and 11-12 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2 lines 2 and 4, "the frame" should be replaced with "the advertising device". This rejection also applies to claim 8.

In claim 2 lines 8-10, the phrase "the at least one slit...relative to the frame" is awkward and confusing. This rejection also applies to claim 8.

In claim 3 lines 2-4, the phrase "the frame...at least one tab" is awkward and confusing. This rejection also applies to claim 5 and claims 9 and 11.

In claim 7 lines 1-4, it is unclear how both the vehicle and the advertisement device, being separate entities, can include the same advertisement.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Ipsen (US 5,487,568).

Ipsen discloses an advertising device adapted for mounting on a vehicle, the device comprising a frame (16/17) and a center section (15) forming the advertising device; the device being adapted for securing to a license plate area of a vehicle; the frame being securable to the vehicle; the frame and the center section being adapted to have advertising thereon; and the frame being separable from the center section.

With respect to claim 2, wherein the frame has at least one slit (of perforation 28) separating the center portion from the frame; the frame having at least one tab (of

perforation 28) connecting the center portion to the frame; the at least one tab being adapted for severing the center portion from the frame.

With respect to claim 3, wherein the tab facilitates separation of the center portion from the frame; the frame including at least one aperture (see figures 7-9, the top strip of the frame includes a row of apertures).

With respect to claim 4, wherein the device is generally rectangular.

With respect to claims 5 and 6, refer to the rejections of claims 3 and 4.

With respect to claims 7-12, refer to the above rejections of claims 1-4.

With respect to claims 1-12, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

It has also been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

It has has been held that the recitation that an element is « capable of» performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

R spons to Argum nts

Applicant's arguments filed 5/23/02 have been fully considered but they are not persuasive.

Regarding the double patenting objection, the examiner maintains this objection. Claims 3-4 are substantially identical to claims 5-6, and claims 9-10 are substantially identical to claims 11-12. The difference being that claims 3 and 9 state that the aperture is for securing the advertising device to the vehicle and claims 5 and 11 state that the aperture is for securing the frame to the vehicle. The advertising device is inclusive of the frame and therefore the claims are essentially one and the same.

Regarding the 35 USC 112 2nd paragraph rejections: contrary to applicant's statement, claims 2 and 8 have not been amended to address and overcome their respective rejections; to expound on the rejection of claim 3 (and claims 5, 9 and 11), the phrase "all members of the class consisting of" should be deleted as it renders the claim unclear and is unnecessary.

Regarding the 102 rejection, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Regarding the referenced affidavit by Joseph Bosco, no affidavit was ever received. And even still, the affidavit would not be sufficient to overcome the 102 rejections of the claims in their present form.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M Hewitt whose telephone number is 703-305-0552. The examiner can normally be reached on M-F, 930am-600pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1020.



LYNNE H. BROWNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3620